

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC D. BLOM,
GREGORY CHERNOFF
and
DANIEL W. KARAKLA

Appeal No. 97-3294
Application 08/408,225¹

ON BRIEF

¹ Application for patent filed March 22, 1995. According to appellants, the application is a continuation-in-part of Application 08/143,835, filed October 27, 1993, abandoned; which is a division of Application 07/818,853, filed January 10, 1992, now Patent No. 5,300,119, issued April 5, 1994.

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Application 08/408,225

Before STONER, Chief Administrative Patent Judge, and CALVERT
and COHEN, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims
1 through 6 and 14 through 16, all of the claims remaining in
the application.²

Appellants' invention pertains to a device for
insertion into an opening of a human body. An understanding
of the invention can be derived from a reading of exemplary
claims 1 and 14, copies of which appear in the APPENDIX to
appellants' main brief (Paper No. 15).

As evidence, the examiner has applied the document
listed below:

Blom et al. (Blom)	4,911,716	Mar. 27, 1990
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A reference of record in this application, applied
in a new ground of rejection, infra, is:

Friese	4,610,659	Sep. 9, 1986
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² We note that the present application, indicated to be a
division of application Serial No. 07/818,853 that matured
into U.S. Patent No. 5,300,119, includes a TERMINAL DISCLAIMER
(Paper No. 8) based upon the specified patent.

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The following rejections are before us for review.

Claim 6 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 5 and 14 through 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Blom.

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Blom.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the answer (Paper No. 16), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 15 and 17).

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims,³ the applied patent,⁴ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issue

We reverse the examiner's rejection of claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite.

³ We understand the recitation of "apparatus" in dependent claims 2 through 5 and claims 15 and 16 to correspond to the "combination" of respective parent claims 1 and 14. The noted language should be made consistent during any further prosecution before the examiner.

⁴ In our evaluation of the applied patent, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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A consideration of the content of parent claim 1 and claim 6 reveals to us that the subject matter of claim 6 is definite in meaning, i.e., the metes and bounds of the claimed subject matter is determinable, as explained below.

Claim 1 is drawn to a combination. As set forth in claim 1, the combination includes a defined device and a retainer. No language is present in claim 1 reflecting that the combination is restricted exclusively to the device and retainer. Thus, the language in dependent claim 6, i.e., "[t]he

combination of claim 1 further comprising an instrument", simply and clearly sets forth, from our perspective, the instrument as an additional entity of the open-ended combination of claim 1. Accordingly, we perceive claim 6 to be readily understandable and, hence, definite under 35 U.S.C. § 112, second paragraph.

The anticipation issue

We reverse the rejection of claims 1 through 5 and 16 under 35 U.S.C. § 102(b), but affirm the rejection of claims 14 and 15 on the same ground.

Claims 1 through 5

Independent claim 1 requires, inter alia, a device body having a flexible first flange provided "on an outside surface of the device body," with the first flange having a deployed, use orientation in which it "projects generally outwardly from the outside surface of the device body."

It is apparent to us that one versed in the art would fairly appreciate the diamond shaped esophageal end 404 of the helical coil spring implant 400 of Blom (Figs. 12 through 15) as a flange-like structure relative to the remaining portion of the coil spring. Nevertheless, we find ourselves in accord with

appellants' view that the teaching of Blom does not address a flange "provided on an outside surface" of a device body, as

expressly set forth in claim 1. More specifically, we understand the noted diamond shaped esophageal end of the implant of Blom as a deformed coil that simply follows uniform coils of the main implant body. Accordingly, it is the viewpoint of this panel of the board that this deformed coil (flange-like structure) at the end of a coil spring cannot be said to be "provided on an outside surface" (underlining added for emphasis) of a device body, as now claimed. Accordingly, the rejection of claims 1 through 5 is reversed.

Claims 14 and 15

Claim 14 requires, inter alia, a device including a resiliently deflectable device body having an insertion cross section transverse to its longitudinal extent which is insufficient to fill an opening in a human body and a larger use cross section transverse to its longitudinal extent, and a retainer removable to permit deployment of the device body to its use cross section. Claim 15 specifies the retainer as being soluble in a fluid.

The law of anticipation does not require that a reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); cert. denied, 465 U.S. 1026 (1984).

With the above in mind, we conclude that the content of claims 14 and 15 reads on the teaching of Blom. In particular, and using the language of appellants' claims, we recognize the esophageal end 402 of Blom as a resiliently deflectable device body having an insertion cross section (Figure 14) which is insufficient to fill the esophagus (an opening in a human body) and having a larger use cross section (Fig. 15); the retainer 416 being soluble in fluid (column 10, lines 10 through 12), i.e., the retainer is removable. In light of the above, we affirm the rejection of claims 14 and 15 under 35 U.S.C. § 102(b).

The argument advanced by appellants does not persuade us as to the patentability of claims 14 and 15.

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Contrary to the view set forth in the main brief (pages 12, 13, 19 and 20), we determined, *supra*, that the content of claims 14 and 15 was anticipated by the Blom patent.

Claim 16

We reverse the rejection of claim 16, a claim requiring means for introducing fluid into contact with a retainer soluble in fluid. Blom discloses the dissolving of half of a gelatin capsule (retainer) 416 upon contact with saliva and mucus, i.e., naturally occurring body fluids. Simply stated, we discern no teaching in Blom of a distinct structure that would be encompassed by the means for introducing a fluid into contact with the retainer, as specified by claim 16.

The obviousness issue

We reverse the rejection of claim 6 under 35 U.S.C. § 103.

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At the outset, we, of course, keep in mind that the burden is on the Patent and Trademark Office to establish a prima facie case of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Evidence provides the basis for a determination that claimed subject matter is unpatentable under 35 U.S.C. § 103. In the circumstance of claim 6, a conclusion of obviousness is made by the examiner relative to a specifically disclosed (specification, pages 9 and 10, and Figs. 8 through 10) and claimed instrument (tube 80) without any evidence whatsoever being relied upon. Lacking evidence of obviousness, we are constrained to reverse the rejection of claim 6.

New ground of rejection

Under the authority of 37 CFR § 1.196(b), we introduce the following new ground of rejection.

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Claim 14 is rejected under 35 U.S.C. § 102(b) as being anticipated by Friese.⁵

The content of claim 14 is readable upon a typical tampon pack, e.g., the tampon packs as disclosed in the Friese document.

In summary, this panel of the board has:

reversed the rejection of claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite;

reversed the rejection of claims 1 through 5 and 16 under 35 U.S.C. § 102(b) as being anticipated by Blom, but affirmed the rejection of claims 14 and 15 on the same ground; and

reversed the rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Blom.

⁵ The Friese reference was listed on appellants' "INFORMATION DISCLOSURE STATEMENT" (Paper No. 3).

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Additionally, we have introduced a new ground of rejection for claim 14 pursuant to our authority under 37 CFR § 1.196(b).

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

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ground of rejection to avoid termination of proceedings (37
CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences

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for final action on the affirmed rejection, including any
timely request for rehearing thereof.

No time period for taking any subsequent action in
con-nection with this appeal may be extended under 37 CFR §
1.136(a).

AFFIRMED-IN-PART
37 CFR § 1.196(b)

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
IAN A. CALVERT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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IRWIN CHARLES COHEN)	
Administrative Patent Judge)	

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